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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/085,890	02/27/2002	David M. Lucas	P1695USA	4131

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PATENT DOCKET DEPARTMENT  
GARDNER CARTON & DOUGLAS LLC  
191 N. WACKER DRIVE, SUITE 3700  
CHICAGO, IL 60606

EXAMINER

AUGHENBAUGH, WALTER

ART UNIT

PAPER NUMBER

1772

DATE MAILED: 08/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.



# Advisory Action

Application No.

10/085,890

Applicant(s)

LUCAS ET AL.

Examiner

Walter B Aughenbaugh

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 31 July 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

## PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See continuation sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 1,2,4-11,13.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_.



## **ADVISORY ACTION**

### ***Acknowledgement of Applicant's Amendments***

1. The amendments made to the claims provided on pages 2-3 of Applicant's After Final Amendment filed July 31, 2003 (Paper #7) have not been entered due to the fact that they raise new issues that would require further consideration and search.

### ***REPEATED REJECTIONS***

2. The 35 U.S.C. 102(b) rejection of claims 1, 2, 4, 5, 9-11 and 13 as anticipated by Stevenson et al. (US 5,254,635) is repeated for the reasons previously of record in paragraph 15 of Paper 6.

3. The 35 U.S.C. 103(a) rejection of claims 6-8 over Stevenson et al. (US 5,254,635) in view of Stevenson (US 4,695,609) is repeated for the reasons previously of record in paragraph 16 of Paper 6.

### ***ANSWERS TO APPLICANTS ARGUMENTS***

4. Applicant's arguments regarding the 35 U.S.C. 102(b) rejection of claims 1, 2, 4, 5, 9-11 and 13 as anticipated by Stevenson et al. (US 5,254,635) made of record in paragraph 15 of Paper 6 have been fully considered but are not persuasive.

Applicant argues that the Stevenson et al. (US 5,254,635) patent "does not qualify as a proper prior art reference because it is not enabling" because it "does not include, in one embodiment, the combination of a liquid polyisoprene emulsion with sulfur, a thiuram and a xanthogen". Stevenson ('635) does indeed teach the combination of a liquid polyisoprene emulsion (i.e. a liquid polyisoprene latex emulsion as claimed), sulfur, a thiuram and a xanthogen as made of record in the 35 U.S.C. 102(b) rejection of claim 1 as anticipated by Stevenson et al. ('635) provided in paragraph 15 of Paper 6.



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Stevenson et al. ('635) plainly teach that sulfur may be a component of the composition (col. 4, lines 35-37) and that the polyisoprene may be in latex (wet) form (col. 5, lines 6-12). The Stevenson ('635) patent is, consequently, enabling and therefore qualifies as a proper prior art reference. Applicant cites MPEP 2121.02- note that MPEP 2121.02 states "applicant must provide evidence showing that a process for making was not known at the time of the invention"; Applicant has not provided evidence showing that the composition claimed by Applicant cannot be made using the disclosure of Stevenson ('635), which teaches the combination of a liquid polyisoprene emulsion (i.e. a liquid polyisoprene latex emulsion as claimed), sulfur, a thiuram and a xanthogen as discussed above and in paragraph 17 of Paper 6. Furthermore, Applicant has not provided evidence showing that the scope of the disclosure of Stevenson ('635) does not include "the combination of a liquid polyisoprene emulsion with sulfur, a thiuram and a xanthogen" in order to make "a stable liquid latex emulsion", "a stable composition with a liquid polyisoprene emulsion" or "a working emulsion", all in the words of Applicant (last paragraph of page 5 of Paper 7).

Examiner requests elaboration as to how Applicant's statement that Stevenson ('635) "does not include the claim limitations in the same order as presented in the claims of [the instant] application" is at all relevant to the patentability of the instant claims (see third full paragraph of page 5 of Paper 7). Certainly the "order" in which limitations of an article claim are "presented" in an application in comparison to that of a patent is irrelevant in determining the patentability of the claim of the application over the claims of the patent.



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The questions that Applicant raises in the first paragraph of page 6 of Paper 7 introduce limitations that are not even included in Applicant's claims. The subject matter that is claimed in the instant application is taught by Stevenson et al. ('635). It is the claims that define the claimed invention, and it is the claims, not specifications that are anticipated or unpatentable. *Constant v. Advanced Micro-Devices Inc.*, 7 USPQ2d 1064. Furthermore, note that the method of forming the polyisoprene article is not germane to the issue of patentability of the polyisoprene article itself.

Applicant states that "None of the thirteen (13) examples included in the specification" teach the liquid polyisoprene latex, emulsion, sulfur, a thiuram and a xanthogen. The examples of Stevenson et al. ('635) are merely examples of embodiments of the invention and do not represent the entire scope of the invention of Stevenson et al. ('635) as disclosed by Stevenson et al. ('635). As Applicant admits in the third paragraph of page 6 of Paper 7, Stevenson et al. ('635) teaches all of these elements, and as was previously made clear in the 35 U.S.C. 102(b) rejection of claim 1 as anticipated by Stevenson et al. ('635) provided in paragraph 15 of Paper 6, Stevenson et al. ('635) teaches the combination of all of these elements.

5. Applicant's arguments regarding the 35 U.S.C. 103(a) rejection of claims 6-8 over Stevenson et al. (US 5,254,635) in view of Stevenson (US 4,695,609) made of record in paragraph 16 of Paper 6 have been fully considered but are not persuasive. Applicant's arguments in regard to this rejection rely entirely on Applicant's arguments in regard to the 35 U.S.C. 102(b) rejection of claims 1, 2, 4, 5, 9-11 and 13 as anticipated by Stevenson et al. (US 5,254,635) made of record in paragraph 15 of Paper 6 that have been addressed above.



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*Conclusion*

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Walter B. Aughenbaugh whose telephone number is 703-305-4511. The examiner can normally be reached on Monday-Thursday from 9:00am to 6:00pm and on alternate Fridays from 9:00am to 5:00pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on 703-308-4251. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

wba

08/11/03

WBA

  
HAROLD PYON  
SUPERVISORY PATENT EXAMINER  
1772

8/12/03